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| 09/475,531      | 12/30/1999  | W. DAVID CONLEY      | 19260-1780          | 6461             |

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JOHN S. PRATT, ESQ  
KILPATRICK STOCKTON, LLP  
1100 PEACHTREE STREET  
SUITE 2800  
ATLANTA, GA 30309

EXAMINER

NGUYEN, DUC MINH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2643

13

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/475,531

Applicant(s)

CONLEY, W. DAVID

Examiner

Duc Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nolting et al (6,351,453).

Consider claim 23. Nolting teaches a method for calculating charge for a telephone call, comprising monitoring a telephone call placed to a called telephone number to determine call parameters (col. 30, ln. 10-39); determining whether the telephone call originated from a telephone having an originating telephone number that corresponds to an entry in a database (col.

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30, ln. 10-39); determining a set activation fee applies to the telephone call; calculating the charge for the telephone call by using the call parameters to calculate a first portion of the charge (col. 30, ln. 10-39); and adding the set activation fee as a second portion of the charge by a network element, so that the set activation fee is independent of the first portion of the charge (since the LEC receives 20 cents or 25 cents for every call from a coin phone to a prepaid calling card number and the cost of the call is charged to the prepaid account. Therefore, the CDR inherently contains a portion for the duration of the call and another portion to indicate that the LEC would receive 20-25 cents).

Consider claim 24. Nolting further teaches the limitations of claim 24 in (col. 7, ln. 10-21. It is noted that Call Detail Record is an accounting record produced by Switches to track Call Type, Time, Duration, Facilities used, Originator, Destination, etc. CDRs are used for customer billing, rate determination, network monitoring, and facility capacity planning).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-11, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolting et al (6,351,453) in view of Lesley (6,188,752).

Consider claims 1-2, 7. Nolting teaches a method for charging a activation fee for a telephone call direct to a called telephone number comprising receiving, at a network element, the called telephone number and billing information from a set activation fee payphone (col. 30, ln. 10-39); inherently identifying the telephone call as having the originating telephone number associated with the set activation fee telephone (col. 30, ln. 10-39); and charging the set activation fee for the telephone call (col. 30, ln. 10-39).

Nolting does not clearly teach determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone.

Lesley teaches determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone (col. 2, ln. 6-29; col. 8, ln. 1-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Nolting, so that the telephone owner can earn some profits and recoup losses from providing telephone service to telephone user.

Consider claims 3, 5. Nolting further teaches determining whether the originating number corresponds to an entry in a billing database (col. 30, ln. 10-39).

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Consider claims 4, 6. Lesley further teaches the use of an SCP database (fig. 1, col. 9, ln. 45-63).

Consider claims 8-10. Nolting teaches a method for charging a fee for a telephone call direct to a called telephone number, comprising receiving the called telephone number and billing information (col. 30, ln. 10-39); and determining whether the telephone number corresponding to the pay telephone is present in the second database (col. 30, ln. 10-39). teach in the event the telephone number corresponding to the pay phone is present in the second data base, charging a set activation fee for the telephone call.

Nolting does not clearly teach in the event that the billing information is present in the first database, placing the telephone call; otherwise, informing the caller that the telephone call may not be placed.

Lesley teaches in the event that the billing information is present in the first database (col. 8, ln. 1-46), placing the telephone call (col. 8, ln. 1-46); otherwise, inherently informing the caller that the telephone call may not be placed (col. 8, ln. 26-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Nolting in order to prevent unauthorized user to use the credit or calling card.

Consider claim 11. Nolting further teaches the billing information comprises the group of credit card (col. 30, ln. 10-28) and Lesley teaches the billing information comprises a telephone account number (col. 6, ln. 65 to col. 7, ln. 25; col. 8, ln. 47-54).

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Consider claim 25. Nolting does not clearly teach determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone.

Lesley teaches prior to placing the telephone call, determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone (col. 2, ln. 6-29; col. 8, ln. 1-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Nolting, so that the telephone owner can earn some profits and recoup losses from providing telephone service to telephone user.

5. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolting et al (6,351,453) in view of Lesley (6,188,752) and Casner (4,517,411).

Consider claims 12, 15-17. Nolting teaches a method for charging a activation fee for a telephone call direct to a called telephone number comprising receiving, at a network element, the called telephone number and billing information from a set activation fee payphone (col. 30, ln. 10-39); inherently identifying the telephone call as having the originating telephone number associated with the set activation fee telephone (col. 30, ln. 10-39); and charging the set activation fee for the telephone call (col. 30, ln. 10-39).

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Nolting does not clearly teach determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone.

Lesley teaches determining if the billing information is valid; if the billing information is valid, then placing a telephone call to the telephone number received from the set activation fee payphone (col. 2, ln. 6-29; col. 8, ln. 1-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lesley into the teachings of Nolting, so that the telephone owner can earn some profits and recoup losses from providing telephone service to telephone user.

Nolting in view of Lesley does not teach generating a false dial tone; receiving the called telephone number and billing information; maintaining the false dial tone; if the billing information is valid, then releasing the false dial tone; seizing a true dial tone.

Casner teaches a method for charging a fee for a telephone call direct to a called telephone number, comprising generating a false dial tone (dial tone generated by the PBX or PABX; col. 3, ln. 38-49); receiving the called telephone number and billing information (credit card, called telephone number, station number and/or room number; col. 3, ln. 38 to col. 4, ln. 17); maintaining the false dial tone (col. 3, ln. 38 to col. 4, ln. 26); if the billing information is valid (col. 4, ln. 18-26), then releasing the false dial tone; seizing a true dial tone (dial tone provided by

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the DDD network; col. 4, ln. 18-22); and placing the telephone call to the called telephone number (col. 3, ln. 38 to col. 4, ln. 26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Casner into the teachings of Nolting in view of Lesley in order to effectively verify the identity of the originating station and billing information.

Consider claims 13-14. Lesley inherently teaches the approval signal and denial signal (col. 7, ln. 14-25; col. 8, ln. 1-45).

6. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden (4,897,870) in view of Nolting et al (6,351,453).

Consider claim 18. Golden teaches a method for charging a fee for a telephone call direct to a called telephone number, comprising generating a false dial tone (dial tone generated by the payphone; col. 5, ln. 32-49); receiving the called telephone number and billing information (col. 5, ln. 32 to col. 6, ln. 3); maintaining the false dial tone (col. 6, ln. 4 to col. 7, ln. 24); if the billing information is valid (col. 6, ln. 4 to col. 7, ln. 24), then inherently releasing the false dial tone; inherently seizing a true dial tone (dial tone provided by the normal switched telephone network; col. 6, ln. 4 to col. 7, ln. 24); and placing the telephone call to the called telephone number (col. 6, ln. 4 to col. 7, ln. 24).

Golden does not clearly teach charging a set activation fee for the telephone call directed to the called telephone number.

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Nolting teaches a method for charging a activation fee for a telephone call direct to a called telephone number comprising receiving, at a network element, the called telephone number and billing information from a set activation fee payphone (col. 30, ln. 10-39); inherently identifying the telephone call as having the originating telephone number associated with the set activation fee telephone (col. 30, ln. 10-39); and charging the set activation fee for the telephone call (col. 30, ln. 10-39). It is further noted that as long as the caller uses a card or account (billing information) to pay for the call, the owner of the payphone would receive the set activation fee of 25 cents to 35 cents. It is also noted that the called telephone number is the destination telephone number. Since making a calling card call includes dialing an access code (calling card service, prepaid calling card numbers, credit card verification system, and the like) + a destination number or called telephone number. Nolting detects the dialing of the access code to determine whether the call is a calling card call, regardless of the destination number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Nolting into the teachings of Golden in order to effectively verify the billing information, so that the telephone owner can earn some profits and recoup losses from providing telephone service to telephone user.

Consider claim 19. Nolting further teaches using the call parameters and activation fee to compute a charge for the telephone call (col. 30, ln. 10-28).

Consider claim 20. Nolting further teaches determining the called telephone number and the billing information originated from a telephone having an originating telephone number (col.

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30, ln. 10-39); and determining the originating telephone number is associated with a set activation fee pay phone (col. 30, ln. 10-39).

Consider claims 21-22. Nolting further teaches determining whether the originating number corresponds to an entry in a billing database (col. 30, ln. 10-39).

### ***Response to Arguments***

7. Applicant's arguments filed 1/21/2003 have been fully considered but they are not persuasive.

Regarding the Nolting reference, applicant states "Nolting does not describe identifying a coin phone using a database or charging a fee based on the identification of the calling phone." In contrast to applicant's assertions, in this case, the LEC owns the coin phone (e.g., the LEC should be getting revenue for calls made to prepaid calling card numbers, for example from a coin phone). Therefore, the coin phone's telephone number is inherently stored in a database at the LEC. Furthermore, the LEC fee is independent from the first portion of the charge in the sense that no matter how much the cost of the call is, the LEC only receive 25 cents to 35 cents.

Applicant also states "Nolting does not describe that a network element adds a set activation fee as a second portion of a charge... and charges to prepaid account are handled by the prepaid calling card provider." In contrast to applicant's assertions, Nolting clearly teaches the LEC bills the prepaid calling card provider (e.g., the LEC needs to find such calls, LEC records those calls in its billing system).

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Regarding the Lesley reference, applicant states "Lesley teaches away from Nolting... Thus, a subscriber would not dial a number associated with a prepaid calling card provider." In contrast to applicant's assertions, the subscriber, in Lesley, still might have to dial a number associated with a prepaid calling card provider (e.g., one example way in which such a service might be requested would be the dialing of a prepay network service telephone number; col. 8, ln. 1-5). Applicant further states the combination of Nolting and Lesley does not teach the set activation fee for the telephone call is charged regardless of the telephone number called. In contrast to applicant's assertions, Lesley clearly illustrates in fig. 3, the telephone number called (e.g., the destination telephone number 74) is the telephone number associated with a recognized destination number in the network such as the special prepay network service number in intelligent network nodes 18 (1-800 in this case for requesting a call connection to device 14f or adding monetary to the account) or another telecommunications device 14f outside of the communication network 12 (col. 5, ln. 34 to col. 6, ln. 42; col. 7, ln. 34-60). Thus, the destination field 74 can be either a 1-800 number or any number in the form of NXX-NXX-XXXX.

In response to applicant's arguments regarding that Casner utilizes his teachings in a PBX environment while Nolting and Lesley utilize their teachings in a network level. The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Mapelsden, 51 CCPA 1123, 329 F.2d

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321, 141 USPQ 30 (1964). In re Henley, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956). It would have been obvious that one of minimum skilled in the art would modify and apply the teachings of Casner in any network environment. The PBX itself functions as a conventional central office. The only difference between the central office and the PBX is the central office owned by a public telephone system and the PBX is smaller and owned by a private telephone system. Applicant further argues that Nolting and Lesley use coin phone and Casner uses a station within a PBX. It is noted that the coin phone in Nolting and Lesley and the station in Casner both can provide credit card or calling card calls. Applicant also argues that the false dial tone generated by the PBX is distinguishable from the dial tone generated by the telephone itself. The examiner disagrees with applicant's argument, since a dial tone is a dial tone. The PBX provides the dial tone in order to eliminate the need of providing each of the station a local dial tone generator. Of course, when the telephone is used in a different network environment, a local dial tone generator would be provided to each telephone (see the rejection of claim 18).

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

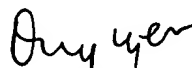
**or faxed to:**

**(703) 872-9315 (Group's Fax numbers)**

**(703) 746-7251 (Examiner's Fax number, only for proposed amendment)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

March 26, 2003

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**